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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/350,875      | 07/09/1999  | JAY S. WALKER        | WD2-98-113          | 8896             |

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EXAMINER

O'CONNOR, GERALD J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3627

DATE MAILED: 12/03/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |
|------------------------------|--------------------------------------|--------------------------------------|
| <b>Office Action Summary</b> | Application No.<br><b>09/350,875</b> | Applicant(s)<br><b>Walker et al.</b> |
|                              | Examiner<br><b>O'Connor</b>          | Art Unit<br><b>3627</b>              |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on September 9, 2002 (Amendment "B")

2a)  This action is **FINAL**.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

4)  Claim(s) 1-15, 32, and 57-71 is/are pending in the application.

4a) Of the above, claim(s) none is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15, 32, and 57-71 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action has been prepared in response to the amendment and arguments filed by applicant on September 9, 2002 (Paper N° 17), in response to the prior Office action.
2. The amendment of claims 1, 3, 32, 63, and 65-66, is hereby acknowledged.

### ***Claim Rejections - 35 USC § 101***

3. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-15, 32, and 57-71 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-15, 32, and 57-71 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Wamerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-15, 32, and 57-71, as best understood, in light of any rejections made under 35 U.S.C. 101, hereinabove, are rejected under 35 U.S.C. 102 as being clearly anticipated by the admitted prior art, as described in the specification and drawings. In making this rejection, note that the various store embodiments recited (store, website, catalog, etc.) and so forth, have been deemed merely "for use" applications of the claimed "method of calculating a purchase total for a transaction," hence, afforded little patentable weight.

7. Claims 1-15, 32, and 57-71, as best understood, in light of any rejections made under 35 U.S.C. 101, hereinabove, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by each of Dlugos (U.S. 5,444,630) and Schultz et al. (U.S. 5,056,019). In making this rejection, note that the various store embodiments recited (store, website, catalog, etc.) and so forth, have been deemed merely "for use" applications of the claimed "method of calculating a purchase total for a transaction," hence, afforded little patentable weight.

***Response to Arguments***

8. Applicant's arguments filed September 9, 2002 have been fully considered, but they are not persuasive.

9. Regarding the argument that the claims are statutory because "calculating a purchase total is a useful, tangible, and concrete result," the invention, *as claimed*, produces *no* useful, tangible, and concrete results, because simply having a computer calculate some number, then having the computer keep that number a secret by merely storing the number within some register of its memory chips, never using the number for any further purpose, nor even communicating the number to human beings for the human beings to be able to make some use of it, fails to effect any "useful, concrete, and tangible result." By way of an example, if applicant's computer were to instead calculate mere random numbers and secretly store those numbers in its memory chips, rather than secretly storing "calculated purchase total" numbers in its memory chips, there would be no perceptible difference whatsoever in the results effected.

10. Regarding the argument that although the claimed methods require no computer, they nonetheless comprise statutory subject matter, current Office practice is to reject, as non-statutory under § 101 for failure to fall within the technological arts, method claims that fail to require any computer, such as the instant claims. To overcome such a rejection, a positive limitation in the body of the claim is required to recite either a computer, *per se*, or else some other element that

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would inherently and necessarily require a computer. Note that, to overcome such a rejection as non-statutory, such a recitation alone, though *necessary*, may not be *sufficient*.

11. Regarding the argument that the admitted prior art fails to disclose the newly added limitation that the percentage differences between first and second prices be different for first and second products, the admitted prior art indeed discloses such a feature. As cited in applicant's response, the prior art systems include those that, "offer a discount on a few selected products" (page 13, lines 6-7). Thus, in the prior art, the percentage difference between first and second prices for a first, discounted product, would be non-zero, and the percentage difference between first and second prices for a second, non-discounted product, would be zero. As zero percent and any non-zero percent comprise different percentages, the prior art indeed includes percentage differences between first and second prices that are different for first and second products.

12. Regarding the argument that the Dlugos reference fails to disclose the newly added limitation that the percentage differences between first and second prices be different for first and second products, the Dlugos reference indeed discloses such a feature. See, for example, column 4, lines 25-27. Additionally, Dlugos discloses that the rates and discounts are different for each package, depending on the carrier a users selects, as well as the locality to which the user is shipping each particular package.

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13. Regarding the argument that the Schultz reference fails to disclose "calculating an initial purchase total for a transaction based on first prices of products and then calculating a second purchase total based on second prices of products if the first purchase total is at least equal to a predetermined threshold," the claimed features are considered inherent in the method of Schultz.

As an example, say the marked price of a first product is \$100 and a rebate is offered of \$5, and say the marked price of a second product is \$10 and a rebate is offered of \$1. Now, obviously, one has to buy the products to claim the rebates. So, the threshold total to get the reduced prices for the two products would be \$110, the first price for the first product would be \$100, the second price for the first product would be \$95, the first price for the second product would be \$10, the second price for the second product would be \$9, and the first purchase total would be \$110. As, the first purchase total would be at least equal to the threshold purchase total of \$110, discounts would apply, thus the second purchase total would become \$104, the discount percentage on the first product being 5% and the different discount percentage on the second product being 10%.

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***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

GJOC



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November 27, 2002